

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/18/09 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5,6, 8, 10, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "reduction" (i.e. "reduced") in the claims is a relative term which renders the claim indefinite. The term "reduction" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There is no set standard over which the amount of acrylamide has been "reduced".

This is especially true since acrylamide is actually formed during heating of food products. There is no heating step recited in the claims. Furthermore, since acrylamide does not originally exist within the food product (pre-heating), it cannot be "reduced" from any point.

***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 5, 6, 8, 10, 17, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Willard (US 4,698,230).
4. Regarding claims 18, 5, 6, 8, 10, 17 Willard discloses a method of treating potatoes comprising the steps of adding an acid such as citric acid (col. 3, lines 50-55) to potato products (column 4, lines 3-21) in concentrations of 0.05-0.30% by weight of the potato product (column 9, lines 60-65). Example 5 discloses the addition of the pH lowering agents to shredded potatoes prior to heat treatment by frying the potatoes. Regarding the drop in pH of the treated food, Willard discloses using citric acid in the concentrations as claimed as the pH lowering ingredient and applying it to potato products. Although the pH drop of the food following the addition of citric acid is not explicitly disclosed one having ordinary skill in the art would expect a drop in pH of the potatoes relative to their intrinsic pH to occur within the claimed range as a result of being treated with citric acid in the concentrations claimed.
5. In response to the limitation 'for reducing acrylamide formation', a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The disclosure of Willard subjects potatoes (carbohydrate food products) to the acid treatment and cooking method steps as claimed. Although

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Willard does not recognize the reduction in acrylamide formation, "[T]he discovery of a previously unappreciated property of a prior art composition (i.e a reduction in acrylamide formation in the heat treated or fried potato product formed by Willard) does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

#### ***Response to Arguments***

6. Applicant's arguments filed 8/18/2009 have been fully considered but they are not persuasive.

7. Applicant argues that claimed method has resulted in a reduction of acrylamide formation in foods that was previously not recognized. As noted above, it has been held that [T]he discovery of a previously unappreciated property of a prior art composition (i.e a reduction in acrylamide formation in the heat treated or fried potato product formed by Willard) does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim

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patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). While applicant's arguments note a difference in objective between the Willard reference and applicant's, no evidence has been provided showing that the method of Willard, which recites the claimed method steps will not result in a reduction in acrylamide formation.

8. It is further noted that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KRAUSE whose telephone number is (571)270-7094. The examiner can normally be reached on 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 1794

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